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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/074,009   | 02/14/2002  | Samuel H. Slishman   | UNME-0118-1         | 9066             |
| 21186  | 7590        | 10/04/2005           | EXAMINER            |                  |
| SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH<br>1600 TCF TOWER<br>121 SOUTH EIGHT STREET<br>MINNEAPOLIS, MN 55402 |             |                      | MENDEZ, MANUEL A    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3763                |                  |

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/074,009

Applicant(s)

SLISHMAN, SAMUEL H.

Examiner

Manuel Mendez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 7, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 4, 7, 28 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over **George et al., in view of French Publication 2083725, United Kingdom Patent No. 364528, and in further view of Naatz, Broselow, Munch, and Turner.**

George et al., discloses a syringe having a barrel and having a scale with volumetric measuring indicia. George et al., does not disclose a syringe barrel having numeric non-volumetric measuring indicia. However, the use of numeric non-volumetric measuring indicia is conventional in the art as evidenced by the teachings of French Publication 2083725 and United Kingdom Patent No. 364,528.

French Publication 2083725 discloses a system characterized by the fact that the medication to be used, orally, or by injection, is bottled in concentrated form in a flask or container which is marked with calibrations or graduations which permit the dilution of the medication so as to obtain a dilution of the active ingredient which will correspond to the weight or body surface area of the individual. Additionally, figure 1, shows a container having numeric non-volumetric measuring indicia. In figure 9, United

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Kingdom Patent No. 364,528 shows a container having a scale that indicates the dosage for a child and for an adult.

Based on the teachings of French Publication 2083725 and United Kingdom Patent No. 364,528, for a person of ordinary skill in the art, modifying George et al., with numeric non-volumetric measuring indicia as taught by the cited patents would have been considered obvious because such modification would have increased the accuracy of infusing medication into the body and more importantly, the avoidance of errors during the infusion process.

Concerning the use of multiple numeric non-volumetric measuring indicia, the case law has established that the duplication of a well-known element of an apparatus should not provide patentable weight to the claim. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Therefore, the use of multiple numeric non-volumetric measuring indicia in a container such as a syringe should have been a modification considered obvious by a person of ordinary skill in the art.

The examiner has included the **Naatz, Broselow, Munch, and Turner** patents to further demonstrate the conventionality of using numeric non-volumetric measuring indicia in containers.

### ***Conclusion***

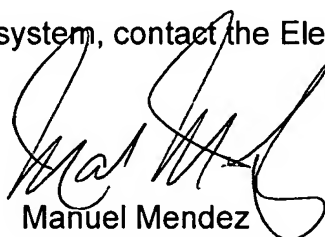
In view of the new grounds for rejection, this action is not a final office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel Mendez whose telephone number is 703-272-4977. The examiner can normally be reached on 0730-1800 hrs.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Manuel Mendez  
Primary Examiner  
Art Unit 3763

MM